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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,065	12/19/2001	Ghita Lanzendorfer	Beiersdorf 758-WCG	8343

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WILLIAM GERSTENZANG  
NORRIS, MC LAUGHLIN & MARCUS, P.A.  
220 EAST 42ND STREET, 30TH FLOOR  
NEW YORK, NY 10017

EXAMINER

JIANG, SHAOJIA A

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 05/06/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/025,065	LANZENDORFER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Shaojia A. Jiang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 January 2003.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____                                     |

## **DETAILED ACTION**

This Office Action is a response to Applicant's amendment and response filed on January 16, 2003 in Paper No. 8 wherein claims 1, 3-4, and 6-8 have been amended. Currently, claims 1-8 are pending in this application.

### *Information Disclosure Statement (IDS)*

Applicants' IDS submitted January 16, 2003 in Paper No. 9 with the English language abstracts for those Germany patents and EP patents listed in Applicants' IDS submitted December 19, 2001 and June 6, 2002, is acknowledged.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beerse et al. (6,294,186) for reasons of record stated in the Office Action dated October 16, 2002.

Applicant's remarks filed on January 16, 2003 in Paper No. 8 with respect to this rejection made under 35 U.S.C. 103(a) in the previous Office Action have been fully

considered but are not deemed persuasive as to the nonobviousness of the claimed invention over the prior art for the following reasons.

Applicant's arguments regarding "improper to 'pick and choose' elements" and "based on the hindsight combination" in this rejection have been considered but are not found persuasive. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). See MPEP 2145. In the instant case, more importantly, Beerse et al. clearly discloses that the compositions therein, an oil-in-water system, comprises up to 90% water, lipid phase such as mineral oil and waxes, one or more emulsifiers which may be up to 10%, and Aristoflex AVC (ammonium acryloyldimethyltaurates/vinylpyrrolidone copolymer) in amount of 2% wt, as discussed in the previous Office Action. Hence, the composition of Beerse comprises every element in claim 1 herein.

It is noted that the transitional phrases "comprising" is employed in the instant claimed composition. Applicant is requested to note that the transitional term "comprising" is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See MPEP 2111.03. Thus, the instant claims are clearly read on the teachings of Beerse and the use of 'pick and choose' elements to make an

obvious rejection is not seen to be improper. Further, no improper hindsight is seen.

The claimed invention is clearly obvious in view of the prior art.

Claims 4-5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beerse et al. (6,294,186 PTO-892) in view of Applicant's admission regarding the prior art in the specification at page 14-19 for reasons of record stated in the Office Action dated October 16, 2002.

Applicant's remarks filed on January 16, 2003 in Paper No. 8 with respect to this rejection made under 35 U.S.C. 103(a) in the previous Office Action have been fully considered but are not deemed persuasive as to the nonobviousness of the claimed invention over the prior art for the following reasons.

Applicant's argument that the prior art does not provide a suggestion or motivation to make such a combination, is not found convincing. As discussed in the previous Office Action, adding dyes coloring pigments to a cosmetic composition is considered well within conventional skills in cosmetic science or industry, involving merely routine skill in the art. It has been held that it is within the skill in the art to select optimal parameters, ingredients, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

Furthermore, Applicant's Examples 1-7 in the specification at pages 28-30 herein have been fully considered but are not deemed persuasive as to the nonobviousness and/or unexpected results of the claimed invention over the prior art. Examples 1-7 provide no clear and convincing evidence of nonobviousness or unexpected results over the cited prior art since there is no comparison to the same present, i.e., side-by-

side comparison. Therefore, the evidence presented in specification herein is not seen to be clear and convincing in support the nonobviousness of the instant claimed invention over the prior art.

For the above stated reasons, said claims are properly rejected under 35 U.S.C. 103(a). Therefore, said rejection is adhered to.

In view of the rejections to the pending claims set forth above, no claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

S. Anna Jiang, Ph.D.  
Patent Examiner, AU 1617  
April 30, 2003

  
SREENI PADMANABHAN  
PRIMARY EXAMINER

5/4/03